

December 12, 2005
Case No. GP-304345 (2760/159)
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— REMARKS —

Support for the claim amendments is found, *inter alia*, on page 14 of the specification. Each claim amendment has been entered, not to avoid any reference, but rather to clarify the claims.

Claims 1-4, 6-8, 10-13, 15-18 and 20 have been rejected under 35 U.S.C. §102(e) as anticipated by McDonnell. This rejection is traversed.

In order to maintain this §102(e) rejection, each and every element of the claims must be disclosed by the reference in at least as great detail as claimed. At a minimum, McDonnell fails to teach or suggest “detecting, at a vehicle system module, at least one wireless short-distance communication network identification signal, the vehicle system module including software and hardware components for operating, controlling or monitoring one or more vehicle systems, and the vehicle system module coupled to a vehicle communication bus” as claimed in claims 1, 11 and 20.

At most, McDonnell discloses a mobile device 20 including a short range wireless transceiver subsystem 21; a cellular radio subsystem 22; and a data-handling subsystem 25. See McDonnell ¶¶23-26.

Additionally, however, claims 9 and 18 each require both detecting a wireless network information upload trigger, and initiating a wireless network information transmission to the service provider responsive to the detected wireless network information upload trigger. At most, McDonnell discloses “collect[ing] information over a period from a number of portals and then upload it all at once to the database system, either via PLMN 10 or another network, such as the internet.” See, ¶38 of McDonnell. McDonnell does not teach any trigger, much less detecting a wireless network information trigger.

Therefore, McDonnell cannot anticipate the instant invention, and Applicants request withdrawal of the rejections to claims 1, 11, and 20, as well as claims 2-4, 6-8, 12-13, and 15-19 depending directly or indirectly from claims 1 or 11. Claim 19 has been included in this list as Applicants believe the Examiner intended to reject claim 19 for the same reasons as claim 10, as noted on page 5 of the October 3, 2005 office action, even though claim 19 is not listed as rejected on page 2 of the same office action.

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Claims 5 and 14 were rejected as unpatentable over McDonnell in view of Cedervall. This rejection is traversed.

Claims 5 and 14 depend from claims 4 and 11 and are therefore patentable for at least the same reasons as claims 4 and 11.

Additionally, the motivation to combine references can only come from the references, be reasoned from common knowledge in the art, or from legal precedent. "The level of skill in the art cannot be relied upon to provide the suggestion to combine references." MPEP §2143.01. In this case, the Examiner makes no showing that the motivation to combine the references comes from the references or that the motivation comes from legal precedent. Thus, the Examiner appears to be relying on "common knowledge in the art" – however, the Examiner makes no showing of what knowledge is common in the art, such as with official notice or an Examiner's Affidavit. As the motivation cannot come from the level of skill in the art, the Examiner needs to show facts, not allegations, to support that it is common knowledge in the art to combine these references. In view of the Examiner's failure to make such a showing, the §103(a) rejection must fall.

The mere fact that references can be combined does not render the combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), MPEP §2143.01. Merely alleging that each reference teaches a salutary teaching fails to satisfy the Examiner's burden.

Claims 9 and 18 were rejected as unpatentable over McDonnell in view of "well known prior art." This rejection is traversed. Applicants further traverse the Examiner's taking of official notice.

Claims 9 and 18 depend from claims 8 and 11 and are therefore patentable for at least the same reasons as claims 8 and 11.

Withdrawal of the rejections to claims 5, 9, 14, and 18 is requested.

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SUMMARY

The Applicants respectfully submit that claims 1-20 herein fully satisfy the requirements of 35 U.S.C. §§ 102, 103 and 112. In view of the foregoing, favorable consideration and passage to issue of the present application is respectfully requested. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

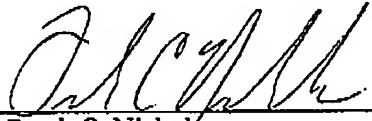
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Respectfully submitted,
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